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Docket No. AUS920000488US1

Serial No. 09/704,569

Atty: DAM / JVL

Applicant: Rodriguez, et al.

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IBM DOCKET NO. AUS920000488US1

DATE: June 27, 2005

Application Serial No.: 09/704,569

Sir:

Assignee Name: International Business Machines Corporation
Assignee Residence: Armonk, New York

Transmitted herewith for filing is the Patent Application of:

Inventors: Rodriguez, et al.

For: System and Method for Automating Travel Agent Operations

Enclosed are:

☒ Appeal Brief .

Any additional filing fees have been calculated as shown below:

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Respectfully submitted,

By Leslie A. Van Leeuwen
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JUN 28 2005In re application of:
Rodriguez et al.

Serial No.: 09/704,569

Filed: November 3, 2000

Title: System and Method for Automating
Travel Agent Operations

§ Group Art Unit: 3623
 § Confirmation No.: 2337
 § Examiner: Robinson Boyce, Akiba K.
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 § Attorney Docket No. AUS920000488US1
 §
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 § IBM Corporation
 § Intellectual Property Law Dept.
 § 11400 Burnet Road
 § Austin, Texas 78758
 §

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By:

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 Leslie A. Van Leeuwen

Date

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APPELLANTS' BRIEF (37 CFR § 41.37)

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06/29/2005 MBINAS 00000039 090447 09704569

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A. INTRODUCTORY COMMENTS

This brief is filed in support of the previously filed Notice of Appeal, filed in this case on May 16, 2005, which appealed from the decision of the Examiner dated February 16, 2005, finally rejecting claims 1, 3-10, 14, 15, 18, 20-23, 25, 27, 28, 30-33, 35, and 37-41. Please charge the required fee under 37 CFR § 41.20(b)(2) to IBM Corporation Deposit Account No. 09-0447.

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 Rodriguez - 09/704,569

Atty Ref. No. IBM-0031

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No extension of time is believed to be necessary. If, however, an extension of time is required, the extension is requested, and the undersigned hereby authorizes the Commissioner to charge any fees for this extension to IBM Corporation Deposit Account No. 09-0447.

B. REAL PARTY IN INTEREST

The real party in interest in this appeal is International Business Machines Corporation, which is the assignee of the entire right, title, and interest in the above-identified patent application.

C. RELATED APPEALS AND INTERFERENCES

With respect to other prior or pending appeals, interferences, or judicial proceedings that are related to, will directly affect, be directly affected by, or have a bearing on the Board's decision in the pending appeal, there are no such prior or pending appeals, interferences, or judicial proceeding known to Appellants, Appellants' legal representative, or assignee.

D. STATUS OF CLAIMS*1. Total number of claims in application*

There are 29 claims pending. Three claims are independent claims (1, 18, and 28), and the remaining claims are dependent claims.

2. Status of all claims in application

- Claims canceled: 2, 11-13, 16, 17, 19, 24, 26, 29, 34, and 36.
- Claims withdrawn from consideration but not canceled: None
- Claims pending: 1, 3-10, 14, 15, 18, 20-23, 25, 27, 28, 30-33, 35, and 37-41.
- Claims allowed: None
- Claims rejected: 1, 3-10, 14, 15, 18, 20-23, 25, 27, 28, 30-33, 35, and 37-41.

3. Claims on appeal

The claims on appeal are: 1, 3-10, 14, 15, 18, 20-23, 25, 27, 28, 30-33, 35, and 37-41.

PATENT**E. STATUS OF AMENDMENTS**

All amendments have been entered in this case. No amendments have been made to the claims after the Final Office Action.

F. SUMMARY OF CLAIMED SUBJECT MATTER

Appellants provide a concise summary of the claimed subject matter as follows. Claims 1, 18, and 28 are independent claims. Note that claims 1, 3-10, 14, 15, 38, and 41 are method claims, claims 18, 20-23, 25, 27, and 39 are information handling system claims, and claims 28, 30-33, 35, 37, and 40 are computer program product claims. Independent claims 18 and 28 include means plus function limitations that correspond to the method steps set forth in independent claim 1. An information handling system capable of implementing Appellants' invention, as claimed in independent claim 18, is shown in Figures 3, 4, 15, and 21, and described in Appellants' specification on page 21, line 19 through page 24, line 10, page 24, line 11 through page 26, line 2, page 48, line 3 through page 51, line 9, and page 59, line 16 through page 60, line 29. Support for independent computer program product claim 28 is described in Appellants' specification on page 61, lines 1-18. In addition, support for each of the method steps and means plus function limitations of the independent claims are discussed below. The specific citations to Appellants' Figures and Specification are meant to be exemplary in nature, and do not limit the scope of the claims. In particular, the citations below do not limit the scope of equivalents as provided under 35 U.S.C. § 112, sixth paragraph.

The claimed invention is a method, information handling system, and computer program product for handling travel arrangements, including scheduling travel arrangements using a computer system (see e.g., Figure 4, reference numerals 415 and 435; page 24, line 11 through page 26, line 2; also see Figure 7, reference numeral 720; page 30, line 20 through page 31, line 26; also see Figures 15 through 20; page 48, line 2 through page 59, line 15); recording the scheduled travel arrangements on a nonvolatile storage device connected to the computer system (see e.g., Figure 15, reference numeral 1515; page 48, line 2 through page 51, line 9); and sending one or more automated requests corresponding to the travel arrangements from the computer system to one or more service agents, wherein the automated requests are based on a traveler's user profile, and wherein at least one of the service agents are selected from the group

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consisting of a delivery service agent, a telephone system, an electronic calendar system, and a medical information system (see e.g., Figure 4, reference numerals 460 through 496; page 24, line 11 through page 26, line 2; also see Figure 5, reference numeral 580; page 26, line 2 through 27, line 30; also see Figure 6, reference numerals 670, 675, and 680; page 28, line 1 through page 30, line 19; also see Figure 7, reference numerals 750, 760, and 780; page 30, line 20 through page 31, line 26; also see Figure 8, reference numerals 840 through 890; page 31, line 27 through page 33, line 3).

Appellants argue the claims in several groups, and, as required by 37 C.F.R. §41.37(c)(1)(v), Appellants provide support from the specification for the means plus function elements of each dependent claim argued separately below.

Dependent claims 27 and 37 are argued separately below and include means for receiving the automated request at a second information handling system (see e.g., Figure 8, reference numeral 840; page 31, line 27 through page 33, line 3); means for searching a database connected to the second information handling system for requested information (see e.g., Figure 8, reference numeral 840; page 31, line 27 through page 33, line 3); and means for downloading destination related medical information resulting from the searching to a computing device that is accessible by a user (see e.g., Figure 8, reference numeral 870; page 31, line 27 through page 33, line 3).

Dependent claims 22 and 32 are argued as part of a separate group below and include wherein the service agents include one or more of the telephone systems and wherein the means for sending automated requests include means for configuring a telephone based on the automated requests (see e.g., Figure 4, reference numerals 496 and 498; page 24, line 11 through page 26, line 2; also see Figure 6, reference numerals 610, 615, 670, and 675; page 28, line 1 through page 30, line 19).

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G. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

Claims 1, 3, 18, 20, 27, 28, 30, and 37 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Tognazzini et al., U.S. Patent No. 5,790,974 (hereinafter Tognazzini), in view of Flake et al., U.S. Patent No. 5,832,451 (hereinafter Flake). Although the Examiner did not include claims 25, 35, and 41 in the list of rejected claims (see Final Office Action, page 2, line 16), the Examiner did discuss claims 25, 35, and 41 in this section of the Final Office Action (see Final Rejection, page 6, lines 3-9), and so Appellants assume that claims 25, 35, and 41 also stand rejected under 35 U.S.C. § 103(a) based on Tognazzini and Flake. Claims 4-10, 21-23, and 31-33 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Tognazzini in view of Flake and further in view of Levine, U.S. Patent No. 6,076,121 (hereinafter Levine). Claims 14 and 15 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Tognazzini in view of Flake and further in view of Berman et al., U.S. Patent No. 5,995,939 (hereinafter Berman). Claims 38-40 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Tognazzini in view of Flake and further in view of Felger, U.S. Patent No. 6,553,108 (hereinafter Felger).

H. ARGUMENTS -**1. Claims 1, 3, 18, 20, 25, 28, 30, 35, And 41 Are Patentable Over Tognazzini In View Of Flake****a. There Is No Motivation To Combine Tognazzini And Flake**

MPEP § 706.02(j) states, inter alia:

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. In re Vaack, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). See MPEP § 2143 - § 2143.03 for decisions pertinent to each of these criteria.

MPEP § 2143.01 states, inter alia (emphasis added):

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"There are three possible sources for a motivation to combine references: the nature of the problem to be solved, the teachings of the prior art, and the knowledge of persons of ordinary skill in the art." *In re Rouffet*, 149 F.3d 1350, 1357, 47 USPQ2d 1453, 1457-58 (Fed. Cir. 1998) (The combination of the references taught every element of the claimed invention, however without a motivation to combine, a rejection based on a *prima facie* case of obvious was held improper.). The level of skill in the art cannot be relied upon to provide the suggestion to combine references. *Al-Site Corp. v. VSI Int'l Inc.*, 174 F.3d 1308, 50 USPQ2d 1161 (Fed. Cir. 1999).

"In determining the propriety of the Patent Office case for obviousness in the first instance, it is necessary to ascertain whether or not the reference teachings would appear to be sufficient for one of ordinary skill in the relevant art having the reference before him to make the proposed substitution, combination, or other modification." *In re Linter*, 458 F.2d 1013, 1016, 173 USPQ 560, 562 (CCPA 1972).

Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art. "The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art." *In re Kotzab*, 217 F.3d 1365, 1370, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000). See also *In re Lee*, 277 F.3d 1338, 1342-44, 61 USPQ2d 1430, 1433-34 (Fed. Cir. 2002) (discussing the importance of relying on objective evidence and making specific factual findings with respect to the motivation to combine references); *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

FACT THAT REFERENCES CAN BE COMBINED OR MODIFIED IS NOT SUFFICIENT TO ESTABLISH PRIMA FACIE OBVIOUSNESS

The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990) (Claims were directed to an apparatus for producing an aerated cementitious composition by drawing air into the cementitious composition by driving the output pump at a capacity greater than the feed rate. The prior art reference taught that the feed means can be run at a variable speed, however the court found that this does not require that the output pump be run at the claimed speed so that air is drawn into the mixing chamber and is entrained in the ingredients during operation. Although a prior art device "may be capable of being modified to run the way the apparatus is claimed, there must be a suggestion or motivation in the reference to do so." 916 F.2d at 682, 16 USPQ2d at 1432.). See also *In re Frutch*, 972 F.2d 1260, 23 USPQ2d 1780 (Fed. Cir. 1992) (flexible landscape edging device which is conformable to a ground surface of varying slope not suggested by combination of prior art references).

Regarding the references used by the Examiner to support the final rejection of claims 1, 3, 18, 20, 25, 28, 30, 35, and 41, Tognazzini discloses a personal calendaring system, including a portable calendaring system and an office calendar system (see Tognazzini, Abstract). The

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portable calendaring system and office calendar system may be synchronized using a two-way wireless transmission (see Tognazzini, Abstract). Flake discloses a method for automatically managing travel service information by storing customer information, business information, and reservation services information in the same database (see Flake, Abstract).

The Examiner states that Flake is "in an analogous art" area to Tognazzini (see Final Office Action, page 3, line 18), but provides absolutely no showing of how one of ordinary skill in the art would be motivated to combine Tognazzini and Flake. Tognazzini is a calendaring system that allows users to synchronize their office calendars with their portable calendars. Flake is a travel service management information system that uses a database to store data that may be useful when making travel reservations for a customer. There is simply no motivation, found in the prior art, to combine the references of Tognazzini and Flake. Instead, it is obvious that the Examiner improperly used Appellants' claims as "guideposts" in selecting the references and simply concluded that it would be "obvious" to combine the references. In doing so, Appellants assert that the Examiner used impermissible hindsight in combining Tognazzini and Flake in order to support a rejection of Appellants' claims. As stated in MPEP § 2143.03, "[t]he mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination" (emphasis added). In this case, the prior art simply does not suggest the desirability of combining these two references.

Appellants assert that the Examiner fails to satisfy the burden set forth in MPEP §§ 706.02(j) and 2143.03 in support of an obviousness objection, particularly because there is no motivation to combine the references. Furthermore, the Examiner fails to explain how combining the calendar synchronization system of Tognazzini with the travel service management information system of Flake would result in a workable solution without relying on Appellants' disclosure. Thus, Appellants contend that the Examiner used impermissible hindsight in rejecting Appellants' claims.

For the reasons set forth above, Appellants respectfully submit that claims 1, 3, 18, 20, 25, 28, 30, 35, and 41 are not obvious, and are therefore patentable over Tognazzini in view of Flake.

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b. Tognazzini And Flake Do Not Teach Or Suggest Claims 1, 3, 18, 20, 25, 28, 30, 35, and 41

Neither Tognazzini nor Flake teaches or suggests "sending one or more automated requests corresponding to the travel arrangements from the computer system to one or more service agents, wherein the automated requests are based on a traveler's user profile, and wherein at least one of the service agents are selected from the group consisting of a delivery service agent, a telephone system, an electronic calendar system, and a medical information system," as taught and claimed by Appellants in independent claims 1, 18, and 28. The Examiner cites Tognazzini at col. 9, lines 17-21 as sending one or more requests corresponding to the travel arrangements from the computer system to one or more service agents (see Final Office Action, page 3, lines 4-10). However, the cited section of Tognazzini discusses the situation that arises when a portable calendaring system sends an override command to an office calendar system "identifying a priority calendar entry between conflicting entries in the office calendar system and the portable calendar system" (Tognazzini, col. 9, lines 14-16). An override command, as disclosed by Tognazzini, is a command that "includes arbitration information" pertaining to conflicting calendar entries. An override command is not a request "*corresponding to the travel arrangements*" as taught claimed by Appellants. Rather, an override command is a command used to resolve conflicting calendar entries between a portable calendar system and an office calendar system. Therefore, Appellants respectfully submit that Tognazzini neither teaches nor suggests "sending one or more automated requests corresponding to the travel arrangements from the computer system to one or more service agents, wherein the automated requests are based on a traveler's user profile, and wherein at least one of the service agents are selected from the group consisting of a delivery service agent, a telephone system, an electronic calendar system, and a medical information system," as taught and claimed by Appellants in independent claims 1, 18, and 28.

Further, the Examiner admits that "Tognazzini fails to disclose automated requests and wherein the automated requests are based on a traveler's user profile" (see Final Office Action, page 3, lines 11-13). The Examiner then cites Flake at col. 5, lines 9-10 and Abstract, lines 7-10 as disclosing this aspect of Appellants' claims. However, using independent claim 1 as an exemplary claim, Appellants' independent claims include the following elements:

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- scheduling the travel arrangements *using a computer system*;
- recording the scheduled travel arrangements on a nonvolatile storage device connected to the computer system; and
- sending one or more automated requests corresponding to the travel arrangements *from the computer system to one or more service agents*, wherein the automated requests are based on a traveler's user profile, and wherein at least one of the service agents are selected from the group consisting of a delivery service agent, a telephone system, an electronic calendar system, and a medical information system.

Note that Appellants claim "scheduling the travel arrangements using a computer system." Appellants further claim "sending one or more automated requests corresponding to the travel arrangements *from the computer system*," i.e. from the computer system that scheduled the travel arrangements, "to one or more service agents." The automated requests, i.e. the requests that are sent from the computer system that scheduled the travel arrangements to a service agent, are "based on a traveler's user profile."

The Examiner states that Flake shows "that the travel request can be based on the customer profile information" (see Final Office Action, page 3, lines 18-19). However, Appellants are not claiming that *the customer's travel request* is based on the customer profile information. Rather, Appellants are claiming that "automated requests corresponding to the travel arrangements," i.e. *the travel arrangements that have already been made* by the computer system, are sent "from the computer system to one or more service agents." It is these automated requests that are "based on a traveler's user profile." Flake does not teach or suggest that "*the automated requests* are based on a traveler's user profile" as taught and claimed by Appellants. Rather, Flake discloses that a customer's travel request may be processed automatically, rather than by a travel agent (col. 5, lines 9-12). In other words, Flake is concerned with a customer's request to schedule travel arrangements. Flake does not teach or suggest any automated requests that are sent *from* the computer system that schedules the travel arrangements *to* a service agent, which is what Appellants teach and claim in independent claims 1, 18, and 28.

The individual entity profiles disclosed by Flake pertain to "an individual customer's personal information and travel preferences, such as, for example, the customer's name and

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address, employer, seating preference, smoking or non-smoking preference, a list of preferred vendors (e.g., airlines), etc.” (Flake, col.3, line 65 through col. 4, line 3). Individual entity profiles are used by a travel agent to assist in making travel reservations for a customer (see Flake, Abstract, lines 7-10). These individual entity profiles are not used as a basis for sending automated requests from the computer system that schedules the travel arrangements to one or more service agents, as taught and claimed by Appellants. Therefore, Appellants respectfully submit that Flake neither teaches nor suggests “sending one or more automated requests corresponding to the travel arrangements from the computer system to one or more service agents, wherein the automated requests are based on a traveler’s user profile, and wherein at least one of the service agents are selected from the group consisting of a delivery service agent, a telephone system, an electronic calendar system, and a medical information system,” as taught and claimed by Appellants in independent claims 1, 18, and 28.

For the reasons set forth above, Appellants respectfully submit that independent claims 1, 18, and 28 are patentable over Tognazzini in view of Flake. Claims 3 and 41 depend from claim 1, claims 20 and 25 depend from claim 18, and claims 30 and 35 depend from claim 28, and thus are patentable for at least the reasons discussed above. Therefore, Appellants respectfully submit that claims 1, 3, 18, 20, 25, 28, 30, 35, and 41 are patentable over Tognazzini in view of Flake.

2. Claims 27 And 37 Are Patentable Over Tognazzini In View Of Flake

Claim 27 depends from independent claim 18, and claim 37 depends from independent claim 28. Therefore, claims 27 and 37 are patentable for at least the reasons discussed above, including that there is no motivation to combine Tognazzini and Flake. In addition, claims 27 and 37 include the following additional limitations:

- means for receiving the automated request at a second information handling system;
- means for searching a database connected to the second information handling system for requested information;
- means for downloading destination related medical information resulting from the searching to a computing device that is accessible by a user.

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The Examiner cites Tognazzini at col. 3, lines 15-16 and col. 3, lines 18-20 as teaching these elements of claims 27 and 37 (see Final Office Action, page 5, lines 16-22). However, the cited section of Tognazzini reads as follows:

“ . . . a second wireless receiver interface receiving location data, and a second agent generating a personal calendar in the portable calendar system in response to the received office calendar information and the location data, the second agent outputting the secondary user calendar information including changes in the personal calendar relative to the received office calendar information.” (Tognazzini, col. 3, lines 15-21).

Appellants are at a loss to understand where, in this cited section of Tognazzini, or anywhere in Tognazzini for that matter, the Examiner finds “means for searching a database connected to the second information handling system for requested information.” Appellants find absolutely no reference to a database in the cited portion of Tognazzini. Further, Appellants do not find any reference to “means for downloading *destination related medical information* resulting from the searching to a computing device that is accessible by a user.” Appellants do not understand where in Tognazzini the Examiner finds any information pertaining to downloading destination related medical information, as taught and claimed by Appellants.

The Examiner also cites Tognazzini at col. 7, lines 45-51 (see Final Office Action, page 6, lines 1-2). This section of Tognazzini discloses an agent transmitting the location of the portable calendar device to the office calendar system so that a secretary can respond to requests regarding the whereabouts of the portable calendar system. Again, Appellants find absolutely no mention of searching a database for requested information and downloading destination related medical information, as taught and claimed by Appellants.

Appellants further note that, during the discussion of claims 14 and 15, the Examiner admits that Tognazzini and Flake “fail to disclose . . . downloading destination related medical information to a computing device that is accessible by a user” (see Final Office Action, page 12, lines 6-11). By the Examiner’s own admission in the Final Office Action, the rejection of claims 27 and 37 can not be supported using only Tognazzini and Flake.

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For the reasons set forth above, Appellants respectfully submit that claims 27 and 37 are patentable over Tognazzini in view of Flake.

3. Claims 4-6, 21, And 31 Are Patentable Over Tognazzini In View Of Flake And Levine

a. There Is No Motivation To Combine Tognazzini, Flake, and Levine

As discussed above, Appellants respectfully submit that there is no motivation to combine the calendar synchronization system of Tognazzini with the travel service management information system of Flake. Appellants further submit that there is no motivation to combine Levine with either Tognazzini or Flake. In general, Levine teaches a system and method to minimize the number of directory numbers (i.e. telephone numbers) that a user requires. Specifically, Levine teaches addressing and translating addresses in a network by adding a functional property code to each device a user employs (see Levine, Abstract). Levine's functional property codes are used to distinguish a device's "type," such as a telephone or a fax machine, so that more than one device can use the same directory number, and a telephone call can be directed to a particular device using the device's functional property code (see Levine, Abstract). Appellants respectfully submit that there is no motivation to combine the teachings of Levine with either Tognazzini or Flake. Levine's method of network addressing and translation is used in a network where multiple devices exist that have multiple device types. Tognazzini operates in a two-way wireless environment with two devices, each configured to communicate and synchronize with each other. Combining Levine with Tognazzini adds complexity (i.e. a functional property code), and does not provide any added feature or benefit to Tognazzini because functional property codes do not appear to be needed in Tognazzini.

Further, Appellants respectfully submit that there is no motivation to combine the teachings of Levine with Flake as this would also add unnecessary complexity to Flake's travel service management information system. There does not appear to be any need for a functional property code in Flake as the travel information requests are sent over an existing network, where both the sending and receiving end of the network are configured to communicate with each other, and do not appear to require any specification of "device type" in order to communicate.

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Once again, it appears that the Examiner improperly used Appellants' claims as "guideposts" in selecting the references and simply concluded that it would be "obvious" to combine the references. In doing so, Appellants assert that the Examiner used impermissible hindsight in combining Tognazzini, Flake, and Levine in order to support a rejection of Appellants' claims. As stated in MPEP § 2143.03, "[t]he mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination" (emphasis added). In this case, the prior art simply does not suggest the desirability of combining these three references.

Appellants assert that the Examiner fails to satisfy the burden set forth in MPEP §§ 706.02(j) and 2143.03 in support of an obviousness objection, particularly because there is no motivation to combine the references. Furthermore, the Examiner fails to explain how combining the network addressing and translation system of Levine with the calendar synchronization system of Tognazzini and the travel service management information system of Flake would result in a workable solution without relying on Appellants' disclosure. Thus, Appellants contend that the Examiner used impermissible hindsight in rejecting Appellants' claims.

For the reasons set forth above, Appellants respectfully submit that claims 4-6, 21, and 31 are not obvious, and are therefore patentable over Tognazzini in view of Flake and Levine.

b. Tognazzini, Flake, And Levine Do Not Teach Or Suggest Claims 4-6, 21, And 31

Claims 4-6 depend from independent claim 1, claim 21 depends from independent claim 18, and claim 31 depends from independent claim 28, and are therefore patentable for at least the reasons discussed above. In addition, claim 4 adds the elements of "wherein the delivery service agents include one or more parcel services, and wherein the automated requests include one of holding packages for customer pickup, delivering packages on a future date, and leaving packages with a neighbor." Claim 5 adds the elements of "wherein the delivery service agent includes a post office, and wherein the automated requests include at least one of holding mail for customer pickup, delivering mail on a future date, and forwarding mail to another address." Claim 6 adds the elements of "wherein the delivery service agent includes a company mailroom, and wherein the automated requests include at least one of holding mail for future pickup,

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delivering mail on a future date, and forwarding mail to another address.” Claims 21 and 31 add the elements of “wherein the automated requests include at least one of holding packages for future pickup, delivering packages on a future date, and leaving packages at an alternate location.”

The Examiner cites Levine at col. 2, lines 8-14, 14-17, and 28 as disclosing these elements of Appellants’ claims (see Final Office Section, page 6, line 19 through page 9, line 4). However, the cited section of Levine is in Levine’s background section, and is describing a method of determining which physical path to use, i.e. which roads to use, to deliver a parcel. The cited section of Levine reads as follows (emphasis added):

“A mail or parcel system is a simple network. Each resident has a resident address and each business has a corresponding business address, where an address serves as an origin point (the return address) or destination point (the location the item is addressed to). *The links are the roads* and other transportation routes that make the delivery of the mailed items possible. The post offices and parcel handling offices serve as transit point nodes – sorting mail or parcels and directing it to appropriate links for delivery to designated DPs.

...

Provided the DP is legible and meets certain criteria of the network, the office sorts the item according to the link or series of links which optimize the delivery of the item.”

The cited section of Levine does not mention anything about automated requests, and certainly does not teach or suggest the various types of automated requests as taught and claimed by Appellants in claims 4-6, 21, and 31. Levine is simply describing a prior art system for determining how best to route parcels *over the road system* from one point to another. Therefore, Appellants respectfully submit that claims 4-6, 21, and 31 are patentable over Tognazzini in view of Flake and Levine.

4. Claims 7-10, 22, 23, 32 and 33 Are Patentable Over Tognazzini In View Of Flake And Levine

Claim 7 depends from independent claim 1, claims 8-10 depend from claim 7, claim 22 depends from independent claim 18, claim 23 depends from claim 22, claim 32 depends from

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independent claim 28, and claim 33 depends from claim 32. Therefore, claims 7-10, 22, 23, 32, and 33 are patentable for at least the reasons discussed above, including that there is no motivation to combine Tognazzini, Flake, and Levine. In addition, using claim 7 as an exemplary claim, claims 7, 22, and 32 include the additional limitation of "wherein sending automated requests include configuring instructions corresponding to a telephone." The Examiner admits that Tognazzini and Flake do not disclose that the service agents include a telephone system and wherein the automated requests including configuring instructions corresponding to a telephone (see Final Office Action, page 9, lines 5-9). The Examiner then cites Levine at col. 8, lines 45-47 and col. 12, lines 20-35 as disclosing this aspect of Appellants' invention. However, as discussed above, Levine is concerned with "transporting an item between points within the network" (Levine, col. 8, lines 30-32). The network may be a telephone network, as disclosed in col. 8, lines 45-47. Levine teaches addressing and translating addresses in a network by adding a functional property (FP) code to each device a user employs (see Levine, Abstract). Levine's functional property codes are used to distinguish a device's "type," such as a telephone or a fax machine, so that more than one device can use the same directory number, and a telephone call can be directed to a particular device using the device's functional property code (see Levine, Abstract).

The cited section of Levine, i.e. col. 12, lines 20-35, appears to be describing various ways in which a user may enter and modify FP codes. Assigning an FP code to a device is not the same as "sending automated requests" including "*configuring instructions* corresponding to a telephone," as taught and claimed by Appellants. Levine is not concerned with configuring the telephone itself, but, rather, with assigning a functional property code to the telephone (or other device), so that the FP code can be used at a later point in time to route items between points within the network. As further claimed by Appellants in claims 8-10, 23, and 33, the configuring may include registering the telephone with an e-mail system, changing a voicemail greeting, etc. There is nothing in Levine that discloses this type of configuring. Rather, Levine allows an FP code to be assigned to a telephone or other device. Levine does not teach or suggest "sending automated requests" including "*configuring instructions* corresponding to a telephone," as taught and claimed by Appellants. Therefore, Appellants respectfully submit that claims 7-10, 22, 23, 32, and 33 are patentable over Tognazzini in view of Flake and Levine.

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5. Claims 14 and 15 Are Patentable Over Tognazzini In View Of Flake And Bermana. There Is No Motivation To Combine Tognazzini, Flake, and Berman

As discussed above, Appellants respectfully submit that there is no motivation to combine the calendar synchronization system of Tognazzini with the travel service management information system of Flake. Appellants further submit that there is no motivation to combine Berman with either Tognazzini or Flake. Berman purports to teach that service requests, such as ordering a medical test or requesting authorization for a particular procedure, are prepared and e-mailed to the sponsor system of an appropriate service provider. The request is fulfilled and the results e-mailed back (see Abstract). Berman further states that "a complete system . . . typically includes hundreds of client systems and dozens of sponsor system" (col. 2, lines 53-55), and "requires that a database of information, such as the identities of a roster of patients, be built up on the client system" (col. 3, lines 6-8).

Appellants assert that there is no motivation to combine the teachings of Berman with either Tognazzini or Flake. Berman's automated network service request and fulfillment system is targeted toward the health care industry, such as a doctor's office for ordering a specific blood test (col. 4, lines 4-9). In contrast, as discussed above, Tognazzini uses a two-way wireless system to *synchronize calendar entries*. There is no commonality between Tognazzini and Berman and, thus, no motivation to combine. In addition, if Berman were combined with Tognazzini, the combination adds complexity (i.e. e-mail messages), and does not provide any added feature or benefit to Tognazzini because e-mail messages would not assist in the synchronization of calendar entries. Further, Appellants respectfully submit that there is no motivation to combine the teachings of Berman, which has to do with the medical industry, with the teachings of Flake, which has to do with managing travel service information.

Once again, it appears that the Examiner improperly used Appellants' claims as "guideposts" in selecting the references and simply concluded that it would be "obvious" to combine the references. In doing so, Appellants assert that the Examiner used impermissible hindsight in combining Tognazzini, Flake, and Berman in order to support a rejection of Appellants' claims. As stated in MPEP § 2143.03, "[t]he mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also

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suggests the desirability of the combination" (emphasis added). In this case, the prior art simply does not suggest the desirability of combining these three references.

Appellants assert that the Examiner fails to satisfy the burden set forth in MPEP §§ 706.02(j) and 2143.03 in support of an obviousness objection, particularly because there is no motivation to combine the references. Furthermore, the Examiner fails to explain how combining the automated network service request and fulfillment system of Berman with the calendar synchronization system of Tognazzini and the travel service management information system of Flake would result in a workable solution without relying on Appellants' disclosure. Thus, Appellants contend that the Examiner used impermissible hindsight in rejecting Appellants' claims.

For the reasons set forth above, Appellants respectfully submit that claims 14 and 15 are not obvious, and are therefore patentable over Tognazzini in view of Flake and Berman.

b. Tognazzini, Flake, And Berman Do Not Teach Or Suggest Claims 14 And 15

Claim 14 depends from independent claim 1, and claim 15 depends from claim 14. Thus, claims 14 and 15 are patentable for at least the reasons discussed above with regard to independent claim 1. Claim 14 further includes the limitations of:

- receiving the automated request at the medical information system; and
- downloading destination related medical information to a computing device that is accessible by a user in response to the received request.

The Examiner admits that Tognazzini and Flake do not disclose these elements of Appellants' claims, but then cites Berman at col. 3, lines 64-47 and col. 12, lines 24-35 (see Final Office Action, page 12, lines 6-19). Claim 14 depends from claim 1, which specifically claims "automated requests corresponding to the travel arrangements," and further claims that "the automated requests are based on a traveler's user profile." The sections of Berman cited by the Examiner do not have anything to do with travel-related automated requests as taught and claimed by Appellants. Further, the section of Berman cited at col. 12, lines 24-35 is part of Berman's claim 17 that reads as follows:

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17. The system of claim 1, wherein each of said service requests is fulfilled by a known one of a plurality of said sponsor systems, said client system further comprising a database of e-mail addresses for said sponsor systems and further programmed to automatically retrieve the e-mail address from said database for the sponsor system which fulfills the service request for which said retrieved service request screen is pre-formatted, and to use said retrieved e-mail address when e-mailing said service request message through said client system's network communication interface and over said computer network to said remote sponsor mailbox.

The Examiner cites Berman's claim 17 as teaching "downloading destination related medical information to a computing device that is accessible by a user in response to the received request." Appellants are at a loss to understand how Berman's claim 17, which appears to claim retrieving the e-mail address of a sponsoring system, has anything to do with downloading destination related medical information in response to receiving a travel related automated request. Therefore, Appellants respectfully submit that claims 14 and 15 are patentable over Tognazzini in view of Flake and Berman.

6. Claims 38-40 Are Patentable Over Tognazzini in View Of Flake and Felger

a. There Is No Motivation To Combine Tognazzini, Flake, and Felger

As discussed above, Appellants respectfully submit that there is no motivation to combine the calendar synchronization system of Tognazzini with the travel service management information system of Flake. Appellants further submit that there is no motivation to combine Felger with either Tognazzini or Flake. Felger purports to teach a method for billing a communication session between a user and a value-added service (see Felger, Abstract). The communication sessions discussed in Felger include circuit-switched calls, computer-network telephony calls, and multimedia sessions. In contrast, and as discussed above, Tognazzini uses a two-way wireless system to synchronize calendar entries. There is no commonality between Tognazzini and Felger and, thus, no motivation to combine. Further, Appellants respectfully submit that there is no motivation to combine the teachings of Felger, which has to do with

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billing for communications sessions, with the teachings of Flake, which has to do with managing travel service information.

Once again, it appears that the Examiner improperly used Appellants' claims as "guideposts" in selecting the references and simply concluded that it would be "obvious" to combine the references. In doing so, Appellants assert that the Examiner used impermissible hindsight in combining Tognazzini, Flake, and Felger in order to support a rejection of Appellants' claims. As stated in MPEP § 2143.03, "[t]he mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination" (emphasis added). In this case, the prior art simply does not suggest the desirability of combining these three references.

Appellants assert that the Examiner fails to satisfy the burden set forth in MPEP §§ 706.02(j) and 2143.03 in support of an obviousness objection, particularly because there is no motivation to combine the references. Furthermore, the Examiner fails to explain how combining the billing system of Felger with the calendar synchronization system of Tognazzini and the travel service management information system of Flake would result in a workable solution without relying on Appellants' disclosure. Thus, Appellants contend that the Examiner used impermissible hindsight in rejecting Appellants' claims.

For the reasons set forth above, Appellants respectfully submit that claims 38-40 are not obvious, and are therefore patentable over Tognazzini in view of Flake and Felger.

b. Tognazzini, Flake, And Felger Do Not Teach Or Suggest Claims 38-40

Claim 38 depends from independent claim 1, claim 39 depends from independent claim 18, and claim 40 depends from independent claim 28. Thus, claims 38-40 are patentable for at least the reasons discussed above with regard to independent claims 1, 18, and 28. Using claim 38 as an exemplary claim, claims 38-40 add the element of "wherein one of the automated requests results in increasing a user's electronic wallet balance and decreasing a user's bank account balance, the user corresponding to the travel arrangements." The Examiner admits that Tognazzini and Flake do not disclose this aspect of Appellants' invention, but then cites Felger's Abstract and also Felger at col. 13, lines 61-66 (see Final Office Action, page 14, lines 1-21). In claims 38-40, Appellants claim a method, system, and computer program product for "increasing a user's electronic wallet balance and decreasing a user's bank account balance" as one of many

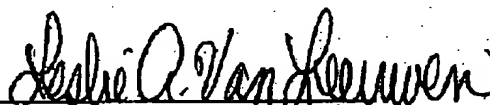
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possible *travel-related automatic requests*. Note that claims 38-40 each depend from an independent claim that specifically claims "automated requests corresponding to the travel arrangements," and further claims that "the automated requests are based on a traveler's user profile." Felger is concerned with billing for communication sessions, and not with automated requests pertaining to travel arrangements, as taught and claimed by Appellants. Felger does not teach or suggest that *a travel-related automatic request* increases a user's electronic wallet balance and decreases a user's bank account balance, as taught and claimed by Appellants. Therefore, Appellants respectfully submit that claims 38-40 are patentable over Tognazzini in view of Flake and Felger.

Conclusion

For the foregoing reasons, Appellants submit that claims 1, 3-10, 14, 15, 18, 20-23, 25, 27, 28, 30-33, 35, and 37-41 are patentable over the cited prior art. Accordingly, Appellants respectfully requests that the Examiner's claim rejections be reversed and claims 1, 3-10, 14, 15, 18, 20-23, 25, 27, 28, 30-33, 35, and 37-41 be allowed.

Respectfully submitted,

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PATENT**I. APPENDIX OF CLAIMS**

1. A method of handling travel arrangements, said method comprising:

scheduling the travel arrangements using a computer system;

recording the scheduled travel arrangements on a nonvolatile storage device connected to the computer system; and

sending one or more automated requests corresponding to the travel arrangements from the computer system to one or more service agents, wherein the automated requests are based on a traveler's user profile, and wherein at least one of the service agents are selected from the group consisting of a delivery service agent, a telephone system, an electronic calendar system, and a medical information system.
3. The method as described in claim 1 further comprising:

sending includes one of sending an automatic email message, sending an automatic facsimile, and sending an automatic data stream using a predefined protocol.
4. The method as described in claim 1 wherein the delivery service agents include one or more parcel services, and

wherein the automated requests include one of holding packages for customer pickup, delivering packages on a future date, and leaving packages with a neighbor.
5. The method as described in claim 1 wherein the delivery service agent includes a post office, and

wherein the automated requests include at least one of holding mail for customer pickup, delivering mail on a future date, and forwarding mail to another address.
6. The method as described in claim 1 wherein the delivery service agent includes a company mailroom, and

wherein the automated requests include at least one of holding mail for future pickup, delivering mail on a future date, and forwarding mail to another address.

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7. The method as described in claim 1 wherein the service agents include one or more of the telephone systems and wherein the sending automated requests include configuring instructions corresponding to a telephone.
8. The method as described in claim 7 wherein the configuring requests include at least one of changing a voicemail greeting, forwarding calls received at a first phone number to a second phone number, transferring a caller to an alternate phone number, and providing the caller with an emergency contact.
9. The method as described in claim 7 further comprising:
registering the telephone with an email system prior to the configuring, wherein the registering includes sending a message to the email system.
10. The method as described in claim 7 wherein the transferring further includes:
setting a backup contact name, wherein the backup contact name corresponds with an alternate phone number; and
receiving a predefined signal from a calling telephone requesting the transferring to the alternate phone number.
14. The method as described in claim 1 further comprising:
receiving the automated request at the medical information system; and
downloading destination related medical information to a computing device that is accessible by a user in response to the received request.
15. The method as described in claim 14 wherein the medical information corresponds with one or more medical services offered at a travel destination.
18. An information handling system comprising:
one or more processors;
a memory accessible by the processors;
a nonvolatile storage device accessible by the processors; and

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a travel automation tool, the travel automation tool including:

means for scheduling travel arrangements using a computer system;

means for recording the scheduled travel arrangements on the nonvolatile storage device; and

means for sending one or more automated requests corresponding to the travel arrangements from the computer system to one or more service agents, wherein the automated requests are based on a traveler's user profile, and wherein at least one of the service agents are selected from the group consisting of a delivery service agent, a telephone system, an electronic calendar system, and a medical information system.

20. The information handling system as described in claim 18 wherein the means for sending includes at least one of sending an automatic email message, sending an automatic facsimile, and sending an automatic data stream using a predefined protocol.
21. The information handling system as described in claim 18 wherein the automated requests include at least one of holding packages for future pickup, delivering packages on a future date, and leaving packages at an alternate location.
22. The information handling system as described in claim 18 wherein the service agents include one or more of the telephone systems and wherein the means for sending automated requests include means for configuring a telephone based on the automated requests.
23. The information handling system as described in claim 22 further comprising:
means for registering the telephone with an email system prior to the configuring, wherein the registering includes means for sending a message to the email system.
25. The information handling system as described in claim 18 further comprising:
means for receiving the automated request at the electronic calendar system; and

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means for updating an electronic calendar maintained by the electronic calendar system with information related to the travel arrangements.

27. The information handling system as described in claim 18 further comprising:

means for receiving the automated request at a second information handling system;

means for searching a database connected to the second information handling system for requested information;

means for downloading destination related medical information resulting from the searching to a computing device that is accessible by a user.

28. A computer program product for handling travel arrangements, said computer program product comprising:

means for scheduling the travel arrangements using a computer system;

means for recording the scheduled travel arrangements on a nonvolatile storage device connected to the computer system; and

means for sending one or more automated requests corresponding to the travel arrangements from the computer system to one or more service agents, wherein the automated requests are based on a traveler's user profile, and wherein at least one of the service agents are selected from the group consisting of a delivery service agent, a telephone system, an electronic calendar system, and a medical information system.

30. The computer program product as described in claim 28 wherein the means for sending includes at least one of sending an automatic email message, sending an automatic facsimile, and sending an automatic data stream using a predefined protocol.

31. The computer program product as described in claim 28 wherein the automated requests include at least one of holding packages for customer pickup, delivering packages on a future date, and leaving packages at an alternate location.

32. The computer program product as described in claim 28 wherein the service agents include one or more of the telephone systems and wherein the means for sending

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automated requests include means for configuring a telephone based on the automated requests.

33. The computer program product as described in claim 32 further comprising:
means for registering the telephone with an email system prior to the configuring,
wherein the registering includes means for sending a message to the email system.
35. The computer program product as described in claim 28 further comprising:
means for receiving the automated request at the electronic calendar system; and
means for updating an electronic calendar maintained by the electronic calendar system
with information related to the travel arrangements.
37. The computer program product as described in claim 28 further comprising:
means for receiving the automated request at a second computer program product;
means for searching a database connected to the second computer program product for
requested information;
means for downloading destination related medical information resulting from the
searching to a computing device that is accessible by a user.
38. The method of claim 1 wherein one of the automated requests results in increasing a
user's electronic wallet balance and decreasing a user's bank account balance, the user
corresponding to the travel arrangements.
39. The information handling system of claim 18 wherein one of the automated requests
results in increasing a user's electronic wallet balance and decreasing a user's bank
account balance, the user corresponding to the travel arrangements.
40. The computer program product of claim 28 wherein one of the automated requests results
in increasing a user's electronic wallet balance and decreasing a user's bank account
balance, the user corresponding to the travel arrangements.
41. The method as described in claim 1 further comprising:

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receiving the automated request at the electronic calendar system; and
updating an electronic calendar maintained by the electronic calendar system with
information related to the travel arrangements.

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J. EVIDENCE APPENDIX

Not applicable.

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K. RELATED PROCEEDINGS APPENDIX

Not applicable.